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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 4208-4153	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]		Application Number 10/660,549	Filed Sept. 12, 2003
		First Named Inventor Juha Salokannel et al.	
on _____		Art Unit 2618	Examiner Andrew Wendell
Signature _____		Confirmation No. 6427	
_____	Type or printed name		

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

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October 1, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Juha Salokannel et al.

Group Art Unit: 2618

Serial No.: 10/660,549

Examiner: Andrew Wendell

Filed: September 12, 2003

For: METHOD AND SYSTEM FOR REPEAT REQUEST IN HYBRID ULTRA
WIDEBAND-BLUETOOTH RADIO

PRE-APPEAL BRIEF

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Final Official Action dated July 13, 2007, the Applicants respectfully request a Pre-Appeal Conference and submit the following remarks for consideration. This Pre-Appeal Brief is being filed along with a Notice of Appeal and the transmittal Requesting a Pre-Appeal Conference.

REMARKS

I. Status of the Claims:

Claims 1-52 are currently pending.

II. Rejections under 35 U.S.C. § 103(a):

Claims 1-2, 4, 8-10, 13-15, 17, 19, 21, 24-29, 31-38 and 40-51 are finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Wynbeek (US 2003/0032422) in view of Yoshii et al. (US 6,993,343) and further in view of Batra et al. (US 2004/0151109), hereinafter

Batra '109). The remaining dependent claims are rejected on the same three references plus additional references addressing the additional limitations in the dependent claims (except that dependent claim 52 has not been examined or rejected.)

III. Identification of Clear Deficiencies In Prima Facie Case Supporting Rejections

The independent claims 1, 14, 25, 26, 27, 37, 42, and 43 are directed to providing a first wireless communications link for communicating payload data and a second wireless communications link for communicating error control data for the first link, without communicating payload data. The first link can, therefore, more efficiently communicate payload data because the second link communicates the error control data for the first link.

The rejections of record in the Office action of July 3, 2007 are clearly deficient in the Examiner's prima facie case supporting the rejections. The Examiner's prima facie case for rejecting independent claims 1, 14, 25, 26, 27, 37, 42, and 43 is set forth as follows:

The Office action of July 3, 2007, page 3, last full paragraph states:

“Wynbeek fails to teach a link for communicating error control data and transmitting payload data.”

The Office action of July 3, 2007, page 3 (bottom)-4 (top) states:

“Yoshii et al. ... teaches a link for communicating error control data (Col. 5 line 66-Col. 6 line 20) without communicating payload data (Yoshii is silent about communicating payload data which for communicating error control data (Col. 5 line 66-Col. 6 line 20) there should be no payload data and therefore Yoshii reads on the claim limitation.”

The Office action of July 3, 2007, page 4, third paragraph states:

“Batra teaches a UWB transmission link for transmitting payload data.”

In order to establish the prima facie obviousness of a claimed invention, MPEP §2143.03 requires that all the claim limitations must be taught or suggested by the prior art, citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be

considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As quoted above from the Office action of July 3, 2007, page 3 (bottom)-4 (top), the Examiner admits that he has not found any reference teaching the Applicant's claimed providing a first wireless communications link for communicating payload data and a second wireless communications link for communicating error control data for the first link, without communicating payload data.

Wynbeek, Yoshii, and Batra '109 are each silent as to any teaching of a second wireless communications link for communicating error control data for the first link, without communicating payload data. The Wynbeek reference discloses power saving by dividing the uplink and downlink communications in two different bearers, wherein all uplink data is communicated via bearer 1 and all downlink data is communicated via bearer 2, which is clearly in contrast to the Applicant's claimed providing a first wireless communications link for communicating payload data and a second wireless communications link for communicating error control data for the first link, without communicating payload data.

However, the Examiner alleges in the Office action of July 3, 2007, page 3 (bottom)-4 (top) that Yoshii teaches such a link because it "is silent about communicating payload data which for communicating error control data (Col. 5 line 66-Col. 6 line 20) there should be no payload data . . .". In essence, the Examiner appears to allege that this aspect, "without communicating payload data," is inherent in Yoshii.

However, the Examiner has not provided any objective rationale or evidence that this claimed aspect necessarily flows from Yoshii's disclosure that the link communicates error control data. That is, the disclosure in Yoshii of the communication of error control data on a

link is not a clear suggestion that there is no payload data also communicated on that same link.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See MPEP §2112, which reads as follows:

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

The MPEP §2112 goes on to require that the Examiner must provide a rationale or evidence tending to show inherency, the section reading as follows:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

Examiner has not provided any objective a rationale or evidence tending to show inherency in Yoshii's disclosure. There is nothing inherent in Yoshii of the Applicant's claimed second wireless communications link for communicating error control data for the first link, without communicating payload data..

Thus, the rejections of record in the Office action of July 3, 2007 are clearly deficient in the Examiner's prima facie case supporting the rejections of independent claims 1, 14, 25, 26, 27, 37, 42, and 43.

If an independent claim is nonobvious under 35 U.S.C. 103, then MPEP §2143.03 requires that any claim depending therefrom is also nonobvious, citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

In view of the foregoing, claims 1, 14, 25-27, 37 and 42-43 and their dependent claims are believed to be patentably distinguishable over the cited references, individually or in combination.

CONCLUSION

Based on the foregoing remarks, the Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Brief to Deposit Account No. 13-4500, Order No. 4208-4153.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4208-4153.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: October 1, 2007

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